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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,153

03/29/2006

Wolfgang von Deyn

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EXAMINER

LOEWE, SUN JAE Y

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

08/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,153	<b>Applicant(s)</b> DEYN ET AL.	
	<b>Examiner</b> SUN JAE Y. LOEWE	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-29 and 32-43 is/are pending in the application.
- 4a) Of the above claim(s) 20-22, 28, 29 and 33-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19, 23-27, 32, 38-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Claims 19-29 and 32-43 are pending in the instant application. Claims 2—22, 28, 29 and 33-37 are withdrawn.

***Response to Amendment***

2. The claim amendments filed on June 2, 2008 have been fully considered. The following grounds of rejection have been obviated and are thus hereby withdrawn: a) 35 USC 112 1<sup>st</sup> paragraph (Section 7); b) 35 USC 112 2<sup>nd</sup> paragraph (Section 8). The section numbers refer to those from the office action dated January 31, 2008.

3. The remarks filed on June 2, 008 have been fully considered, however, they are not persuasive. The remaining grounds of objection/rejection set forth in the previous office action. See response below to Applicant's arguments.

***Maintained Claim Objections***

4. Claims 19, 23-27, 32 and newly added claims 38-43 are objected to for containing non-elected subject matter. The non-elected subject matter, currently withdrawn pursuant MPEP 803.02, consists of compounds of Formula I that are not the elected species. Applicant will be entitled to rejoinder of non-elected species.

Following is a response to Applicant's remarks:

Applicants believe that the rejections show that the Examiner considers the elected species patentable, and thus has searched and examined the genus (the rejection is based on a homolog of a species other than the elected one.) Therefore, Applicants respectfully submit that the objection is improper at this point. Applicants note that non-elected claims 33-37 should be considered withdrawn from consideration until such time that they can be rejoined.

For clarification, the search and examination was limited to the elected species and the non-elected species of 2-cyano-3-methyl-N-methylbenzenesulfonamide. Applicant is respectfully referred to MPEP 803.02, which guidelines were followed for the examination detailed previously (office action dated January 31, 2008).

***Maintained Claim Rejections - 35 USC § 103***

5. Below are responses to Applicant's remarks:

- a) "At 10 mg/L, compound 21 is one of two compounds having the lowest activity (10%) reported. Because the Office Action proffers no reason beyond homology to select compound 21, Applicants respectfully submit that in view of the whole, this is improper hindsight reasoning. "

The argument has been considered, however, it is not found to be persuasive. Notwithstanding the "non-optimal" activity noted by Applicant, the prior art compound does have aphicidal utility. As such, one of ordinary skill would be motivated to make the change(s) to arrive at the instant invention with reasonable expectation of success in obtaining an additional (perhaps more optimal) aphicidal compound.

- b) "Submitted herewith as Exhibit A is a Declaration Under 35 U.S.C. § 1.132 showing that the presently claimed species (Example 29) is superior to the alleged homolog (identified as "Comparative A"). In Tables 1-3, data show that the activity of Example 29 at a low concentration of 10 ppm is still greater than, or in the case of Cotton Aphids equal to, that of Comparative A at 10x concentrations (100 ppm.) "

The argument has been considered, however, it is not found to be persuasive. The evidence provided does not persuasively indicate unexpected results because the differences disclosed (eg. Table 2; 76-85 vs. 56-65; 100 vs. 76-85) is not considered to be significant.

- c) "Examples in the originally filed specification of the present application and the attached Declaration Under 35 U.S.C. § 1.132 (Exhibit A) show that the present compounds not only possess superior aphicidal activity, but also have been shown to possess activity against other pests. "

The argument has been considered, however, it is not found to be persuasive.

Applicant is respectfully referred to MPEP 2145.II., excerpts below:

## **II. ARGUING ADDITIONAL ADVANTAGES OR LATENT PROPERTIES**

### ***Prima Facie Obviousness Is Not Rebutted by Merely Recognizing Additional Advantages or Latent Prop- erties Present in the Prior Art***

Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention.

.....

"The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious."

For the reasons provided above, the 35 USC rejection is maintained and hereby made FINAL. Claims 19, 26, 27, 32 and newly added claims 38-41 are rejected.

### ***Maintained Double Patenting Rejection***

6. Applicant's response is noted. Because the generic claims remain rejected/objected, the double patenting rejections over copending applications US 11/909,447 and US 11/791,398 are maintained. Claims 19, 23-27, 32 and newly added claims 38-43 are rejected.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe, Ph.D./  
8-18-2008

/Kamal A Saeed, Ph.D./  
Primary Examiner, Art Unit 1626